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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,661	09/03/2003	Thomas Fontana	ARZ-023635-II	8644
7590 Richard C. Stewart, II International Paper 1422 Long Meadow Road Tuxedo, NY 10987			EXAMINER ZEMEL, IRINA SOPJIA	
			ART UNIT 1711	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/654,661

Applicant(s)

FONTANA, THOMAS

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-103 and 106-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-103 and 106-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/15/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 65-86, 95-103, and 106-110 rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/58002.

The rejection stands as per reasons of record. Insofar as the independent claims are amended to recite tall oil fatty acids or Monomer, this limitations are still met by the disclosure of the reference. While overall composition of DTO is different from TOFA, the reference expressly states that some significant residual amounts of fatty acids from TOFA are inherently present in the DTO as discussed in detail on page 6 of the specification. Similarly, it is reasonable believed that at least some amount of Monomer is inherently present in the DTO as it is impossible to remove the entire amounts of volatiles from tall oil. Furthermore, as expressly shown in the discussion on page 6, the amounts of TOFA fatty acids in DTO is quite significant, and in combination with the disclosure of the overall amount of DTO used in the reaction, the lower limitation to the amount of acids (as per, for example, claims 70-71) is still met by the DTO compound used in the disclosed reactions. It is noted that there is no limitation that specifically requires any amount of Monomer to be present in the reaction. The invention as claimed, thus, is still considered to have been anticipated by the disclosure of the reference.

Claims 65-86, 95-103 and 106-110 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2,309,610 to Burrell (of record, hereinafter "Burrell").

Burrell discloses a process for obtaining resin, the process comprising reacting reactants at elevated temperature, the reactants comprising rosin, fatty acid, aldehyde and phenolic compound that is at least trifunctional with respect to reactivity with aldehyde, where the phenolic compound that is at least trifunctional constitutes at least 25 wt% of all phenolic compounds used to form the resin and wherein the fatty acid is tall oil fatty acid. See, for example, illustrative example 12 and the entire disclosure of the patent which expressly discusses all of the claimed components in the claimed amounts. The only component which is not expressly disclosed is the Monomer. However, the TOFA expressly disclosed by the reference inherently comprises at least some amounts of Monomer. In the absence of any quantitative limitations as to the amounts of the Monomer, any amounts inherently present in the TOFA satisfies the limitations of the claims directed solely to Monomer as the fatty acid component. The reference further expressly discloses various uses of the resin such as varnishes, water-based compositions and other uses which fully correspond to the claimed uses.

The invention as claimed in amended claims, thus, is fully disclosed in the cited reference.

Response to Arguments

Applicant's arguments filed 12-11-2006 are have been fully considered but they are not persuasive. The applicants argue with r WO reference that the reference does not disclosed the claimed TOFA or Monomer fatty acids. The examiner disagrees.

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While, as noted above, DTO and TOFA do have different overall compositions, as discussed above the reference expressly teaches that DTO does contain residual amounts of TOFA acids (the reference dedicated entire page 6 to this discussion), and, as disclosed by the reference, the fatty acid components of DTO are "presumably formed, at least in part, from TOFA fatty acids and/or the fatty acid-like and the rosin-like components", the claimed limitation of the fatty acid to be either TOFA or Monomer are inherently met by the DTO fatty acids. (It is noted that the claim language does not preclude any other acids in any other amounts (e=with exception of claims claiming the TOFA acid amounts that can be as low as 5 %) from being present in the reaction composition).

Therefore, the invention as claimed is still considered to have been anticipated by the WO reference.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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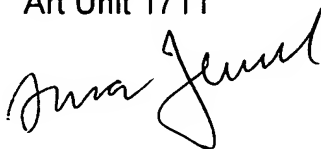
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel
Primary Examiner
Art Unit 1711



ISZ